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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,251	03/31/2004	Gregory J. Wolff	74451P160	9173
8791 7590 07/17/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER BELOUSOV, ANDREY	
			ART UNIT 2174	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,251

Applicant(s)

WOLFF ET AL.

Examiner

Andrew Belousov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/30/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the original filing of March 31, 2004. Claims 1-52 are pending and have been considered below.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Objections

The claims are objected to because Claim 20 and claims 21-23 depending thereon are directed to an article, but claim 20 depends on claim 18, which is a method. It appears as though claim 20 was intended to depend on article Claim 19. For examination purposes, the examiner has considered claim 20 as depending on claim 19. Correction is required in response to this action.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-42 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19-42 are drawn to machine-readable medium, which the applicant has defined in the specification (par. 15) to include transmission

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medium (carrier waves and other digital signals.) The Office considers an electronic signal to be a form of energy. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a compilation of matter. Thus, an electronic transmission signal does not fall within any of the four categories of invention. Therefore, Claims 19-42 are not statutory.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 50 recites the limitation "the sheet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, 49, 50, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballantyne, et al. (5,867,821.)

Claim 1, 19, 31, 38: Ballantyne discloses a method comprising:

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- a. representing a first collection (e.g. patient record) of media objects (e.g. charts, data entry forms, medical forms) using a first sheet (e.g. touch panel; 10:23-27) having a first graphical content representing the media objects (10:10-27);
- b. creating a second collection of media objects from the first collection of media objects (entering information in the forms, notes, etc; 10:10-27); and
- c. re-marking the first sheet to include a second graphical content representing the second collection of media objects (updating patient's medical record; 10:10-27.)

Claim 9, 24, 33: Ballantyne discloses the method defined in claim 1 further comprising accessing the first collection using a first identifier, wherein the first identifier comprises a machine-readable identifier (e.g. bar code; 13:57-59; 12:15-24.)

Claim 10, 25, 34, 41: Ballantyne discloses the method defined in claim 9 wherein the machine-readable identifier comprises a barcode (13:57-59.)

Claim 14: Ballantyne discloses the method defined in claim 1 wherein the first sheet comprises a medical information of a patient (10:10-27.)

Claim 15, 29, 30, 37, 44: Ballantyne discloses the method defined in claim 14 wherein the first collection of media objects comprises patient objects regarding a patient, and further wherein the second collection of media objects represents an updated version of the patient objects for the patient (10:10-27.)

Claim 49: Ballantyne discloses the method defined in claim 48 further comprising determining a difference between representations for the first and second collections; and erasing a portion of the sheet based on the difference between the representations of the first and second collections (updating patient's medical record; 10:10-27.)

Claim 50: Ballantyne discloses a method comprising: erasing a portion of the sheet having a representation of a collection of media objects, wherein the representation includes graphical context to represent the media objects; marking the portion of the sheet with updated information (Fig. 11D: 436.)

Claim 52: Ballantyne discloses the method defined in claim 50 further comprising scanning the portion of the sheet, prior to erasing, to obtain scanned information, and wherein the updated information is based on the scanned information (6:20-31; Fig. 11D.)

Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Sellen et al. (2002/0052888.)

Claim 46: Sellen discloses a method comprising:

- a. scanning a portion of a document (Fig. 5: 86) to obtain first scanned data (Fig. 5: 90); storing the first scanned data in a memory (Fig. 5: 92);

- b. performing an erasing operation on the document at the location of the portion (0037);
 - c. scanning the portion of the document to obtain second scanned data (Fig. 5: 84-94);
 - d. determining whether the first and second scanned data are the same to indicate whether the document was erased (Fig. 5: 52-62.)
4. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Geeslin (2002/0064113.)

Claim 47: Geeslin discloses a method comprising: detecting a writable mark when scanning a coversheet; preventing modification to the coversheet in response to detecting the writable mark (Abstract.)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-8, 12, 13, 20-23, 32, 27, 28, 36, 39, 40, 42, 43, 45, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Kashiwagi et al. (6,396,598.)

Claim 2, 20, 32, 39, 48: Ballantyne discloses the method defined in claim 1, further comprising:

- a. erasing the first sheet (13:11-27); and
- b. adding one or more other media objects to the first collection of media objects to create the second collection of media objects (updating: 13:11-27);

However, Ballantyne does not explicitly disclose:

- c. scanning a first identifier on the sheet; and
- d. marking the first sheet with a second identifier to identify the second collection and the second graphical content.

Kashiwagi discloses a method for using an electronic memo apparatus to handle electronic documents, comprising:

- a. scanning a first identifier on the sheet (11:19-44); and
- b. marking the first sheet with a second identifier to identify the second collection and the second graphical content (17:33-42.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the scanning of an identifier with marking of a second identifier upon creation of a second collection, as taught by Kashiwagi to the disclosure of Ballantyne. One would have been motivated to scan an identifier on the sheet, and then mark it with a second identifier to identify the second collection so as to determine document information for editing and display purposes (11:39.)

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Claim 3: Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein the media objects are scanned pages (6: 27-31.)

Claim 4: Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein the media objects are electronic documents or images from a digital memory card (electronic medical records: Abstract; 10:50.)

Claim 5: Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein marking the first sheet comprises identifying open areas on the sheet based on scanned information and determining where to mark the sheet based on the open areas ("data entry forms": 10:15.)

Claim 6, 22, 40, 43, 45: Ballantyne and Kashiwagi disclose the method defined in claim 2. Kashiwagi further discloses further comprising: accessing the first collection of media objects using the first identifier (12:15-24); and scanning the one or more pages of the one or more other media objects (14:53-64.)

Claim 7, 21, 36: Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein the first identifier and the second identifier are identical (document identifier: 11:60-67; Fig. 7.)

Claim 8, 23: Ballantyne and Kashiwagi disclose the method defined in claim 2.

Ballantyne further discloses wherein re-marking the first sheet comprises identifying open areas on the sheet based on scanned information and determining where to mark the sheet based on the open areas ("data entry forms": 10:15.)

Claim 12, 27: Ballantyne discloses the method defined in claim 1. Ballantyne does not disclose wherein

- a. re-marking the first sheet only occurs in a first mode of operation, and further comprising
- b. marking a second sheet with the second graphical content in a second mode of operation, where the second mode is different than the first mode of operation.

Kashiwagi discloses a method for using an electronic memo apparatus to handle electronic documents wherein

- a. re-marking the first sheet only occurs in a first mode of operation, and further comprising
- b. marking a second sheet with the second graphical content in a second mode of operation, where the second mode is different than the first mode of operation
(Fig. 14: 222-230.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first and second modes of marking first and second sheets, as taught by Kashiwagi to the disclosure of Ballantyne. One would have been motivated to first and second modes of marking first and second sheets so as to

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encompass numerous common media formats that may be incorporated on the sheets (11:39.)

Claim 13, 28: Ballantyne and Kashiwagi disclose the method defined in claim 12.

Ballantyne further discloses wherein marking the second sheet with the second graphical content occurs while erasing the first sheet (updating: 13:11-27.)

Claim 42: Ballantyne and Kashiwagi disclose the method defined in claim 39.

Kashiwagi further discloses further comprising a scanned sheet feeder coupled to the scanner to send the sheet to the erasing unit if the sheet is re-writable (Fig. 1: 62.)

7. Claims 11, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Cardullo et al. (3,713,148.)

Claim 11, 26, 35: Ballantyne discloses the method defined in claim 9. However, Ballantyne does not disclose wherein the first identifier comprises a radio frequency identifier (RFID). However, Official notice is taken that RFID technology is old and well known in the arts (for example, as taught by Cardullo, 3,713,148,) and therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to use RFID as identifiers. One would have been motivated to use RFID tags as they require no internal power, are relatively small in size and are portable (2:30-64.)

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8. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Ludtke et al. (6,260,063.)

Claim 16: Ballantyne discloses the method defined in claim 1. Ballantyne does not further explicitly disclose marking the sheet with a machine-readable indicator that indicates that the sheet is not to be erased. However, Official Notice is taken that it is old and well known in the computing arts to have a write-protection mechanism for electronic documents, such as disclosed in Ludtke (7:34-64.) Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a write-protection mechanism as taught in Ludtke to the disclosure of Ballantyne. One would have been motivated to combine the teaching of Ludtke to that of Ballantyne so as to provide a form of protection against inadvertent deletion / erasure of important documents.

Claim 17: Ballantyne and Ludtke disclose the method defined in claim 16. Ludtke further discloses wherein the indicator is erasable (i.e. flag can be set / removed; 7:34-64.)

Claim 18: Ballantyne and Ludtke disclose the method defined in claim 16. Ludtke further discloses wherein the indicator is one of a predetermined shape, pattern, or color (7:34-64.)

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Sellen et al. (2002/0052888.)

Claim 51: Ballantyne discloses the method defined in claim 50. However, Ballantyne does not explicitly disclose wherein the updated information comprises a timestamp. Sellen teaches a method for an electronic record storage wherein updated information comprises a timestamp (Abstract.) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to update the timestamp upon a updating of the sheet. One would have been motivated to update the timestamp of the sheet to know whether the sheet is up-to-date and accurate (0004.)

Conclusion

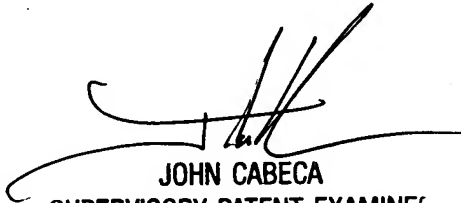
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Belousov whose telephone number is (571) 270-1695. The examiner can normally be reached on Mon-Fri (alternate Fri off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AB
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